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Jim

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/255,222	02/22/99	WILLIAMS	M P2160/170178

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IM22/0525

EXAMINER

HRUSKOCI, P

ART UNIT

PAPER NUMBER

1724

DATE MAILED:

10
05/25/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No. <u>09/255,282</u>	Applicant(s) <u>Williams et al.</u>
Examiner <u>Hruskoci</u>	Group Art Unit <u>1724</u>

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 4-17-00
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-35 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-35 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Sargent et al. 5,234,466. It is submitted that Sargent et al. disclose (see col. 1 lines 54-61 and col. 3 lines 4-13) a method for decreasing the amount of sulfuric acid required by a papermaking process, and adjusting the pH of a process stream or solution of a papermaking process as recited in the instant claims, respectively.

3. Claims 20-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Sargent et al. 5,672,279. It is submitted that Sargent et al. disclose (see col. 1 lines 15 through col. 2 line 20 and col. 3 lines 10 through col. 4 line 10) a method for decreasing the amount of hydrochloric acid required by a papermaking process, and adjusting the pH of a process stream or solution of a papermaking process as recited in the instant claims, respectively.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior

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art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 13-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ackel or Nakajima et al. in view of Sargent et al. 5,234,466.. Ackel (see col. 2 lines 16 through 63) and Nakajima et al. (see col. 1 line 55 through col. 2 line 60) disclose a method for flocculating or precipitating a material in a process stream or solution of a pulping or papermaking process substantially as claimed. The claims differ from Ackel and Nakajima et al. by reciting the addition of urea sulfate. Sargent et al. disclose (see col. 1 lines 54-61 and col. 3 lines 4-13) that it is known in the art to decrease the amount of sulfuric acid required by a papermaking process, or adjust the pH of a process stream or solution of a papermaking process stream by the addition of urea sulfate. It would have been obvious to one skilled in the art to modify the process of Ackel or Nakajima et al. by addition of urea sulfate in view of the teachings of Sargent et al., to aid in adjusting the pH of the stream or solution.

6. Applicants argue that Sargent et al. 5,234,466 is not available as a reference against claims 1-12 because the present application properly claims benefit of the filing date of the '466 patent under 35 USC 120. It is submitted that the subject matter of claims 1-12 is not entitle to this filing date because these claims also recite new subject matter such as "sulfuric acid or aluminum sulfate hydrate", "pulping or papermaking

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process”, and the group recited in claims 6 and 12, which appear to have no clear antecedent basis in the specification of the Sargent et al. patent.

7. Applicants argue that Sargent et al. 5,672,279 is not available as a reference against claims 20-35 because the present application properly claims benefit of the filing date of the '466 patent under 35 USC 120. It is submitted that the subject matter of claims 20-35 is not entitled to this filing date because these claims also recite new subject matter such as “pulping or papermaking process”, and the group recited in claims 27 and 35, which appear to have no clear antecedent basis in the specification of the Sargent et al. patent.

8. Applicants argue that one skilled in the art looking for an alum flocculant replacement would not have been motivated to look in the '466 patent, since suitable alum flocculant replacements are already disclosed by the primary references Ackel and Nakajima et al.. It is noted that the use of alum or alum flocculant replacements are not excluded from the instant claims. It would have been obvious to one skilled in the art to modify the process of Ackel or Nakajima et al. by addition of urea sulfate in view of the teachings of Sargent et al. '466, to aid in adjusting the pH of the stream or solution.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter A. Hruskoci whose telephone number is (703) 308-3839. The examiner can normally be reached on Monday through Friday from 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. David Simmons, can be reached on (703) 308-1972. The fax phone number for this Group is (703) 305-7718.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651.


Peter A. Hruskoci
Primary Examiner
Art Unit 1724

P. Hruskoci
May 24, 2000